



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,533	12/28/2000	Robert Adams	PM 0273215 P9895	6958

7590

01/04/2005

Crystal D Sayles  
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP  
12400 Wilshire Boulevard  
7th Floor  
Los Angeles, CA 90025

EXAMINER

BLAIR, DOUGLAS B

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application No.**

09/750,533

**Applicant(s)**

ADAMS ET AL.

**Examiner**

Douglas B Blair

**Art Unit**

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of copending Application No. 09/948,708. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the elements of the invention claimed in the present application are also claimed in claims 1-30 of 09/948,708.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for

Art Unit: 2142

patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 5-12, 14-18, and 20-21 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,546,616 to Kirsch.
5. Kirsch teaches the invention (as claimed in exemplary claim 16) including a communications system having a shared resource, comprising: a computer-readable medium; and computer-readable program code, stored on the computer-readable medium, adapted to be loaded and executed on the communications system, the computer-readable code performing, monitoring communications to and from a user (col. 11, lines 28-61), determining social network data from the communications to and from the user (col. 11, lines 28-61), determining an access level for the user based on the social network data (col. 11, lines 28-61), configuring an access control list to provide the user the access level determined for accessing the shared resource (col. 12, lines 47-67); and continuously updating the access control list to add and remove entries or to change access levels as the user transitions in and out of a social network or as communications between users changes (col. 12, lines 47-67).
6. Kirsch teaches a communications system (as in claim 17) wherein the communications are e-mail communications (col. 11, lines 28-61).
7. Kirsch teaches a communications system (as in claim 18) wherein the social network data includes resources attached to the communications (col. 11, lines 28-61).
8. Kirsch teaches a communications system (as in claim 20) wherein the access control list includes a user identification and the access level for the user (col. 11, lines 28-61).

Art Unit: 2142

9. Kirsch teaches a communications system (as in claim 21) wherein the resource is a computer system (col. 11, lines 28-61).

10. As to claims 1-3 and 5-6, they feature the same limitations as claims 16-18 and 20-21 and are rejected for the same reasons as claims 16-18 and 20-21.

11. As to claims 7, 11-12, and 14-15, they feature the same limitations as claims 16-18 and 20-21 and are rejected for the same reasons as claims 16-18 and 20-21.

12. As to claim 8, Kirsch teaches a social network including a shared resource provider to provide to the user access to the shared resource based on the access control list (col. 11, lines 28-61).

13. As to claim 9, Kirsch teaches a social network wherein the social network monitor and the social network access controller reside on a single system (col. 11, lines 28-61).

14. As to claim 10, Kirsch teaches a social network wherein the social network monitor and the social network access controller reside on separate systems (col. 11, lines 28-61).

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 4, 13, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,546,616 to Kirsch et al. in view of U.S. Patent Number 6,044,466 to Anand et al..

Art Unit: 2142

17. As to claim 19, Kirsch teaches the subject matter of claim 16; however Kirsch does not teach the access level as being permissions.

Anand teaches a dynamic access policy including permissions information (col. 5, lines 1-16).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Kirsch regarding managing the access of user's to a system with the teachings of Anand regarding a dynamic access policy including permissions because permission prevent unauthorized access to resources (Anand, col. 1, lines 37-42).

18. As to claims 4 and 13, they feature the same limitations as claim 19 and are rejected for the same reasons as claim 19.

19. Claims 22, 24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,546,616 to Kirsch et al. in view of U.S. Patent Number 6,654,787 to Aronson et al..

20. As to claim 22, Kirsch teaches the method of claim 1; however Kirsch does not explicitly locating a keyword in an email.

Aronson teaches a social network including monitoring communication for particular keywords, wherein the access level is granted based on the number of occurrences of the particular keywords (col. 5, lines 50-67).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Kirsch regarding managing the access of user's

Art Unit: 2142

to a system with the teachings of Aronson regarding monitoring for a keyword because keywords are useful for eliminating unwanted emails (Aronson, col. 5, lines 50-67).

21. As to claims 24 and 26, they are rejected for the same reasons as claim 22.

22. Claims 23, 25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,546,616 to Kirsch et al. in view of U.S. Patent Number 6,654,787 to Aronson et al. in further view of U.S. Patent Number 6,711,570 to Goldberg et al..

23. As to claim 23, the Kirsch-Aronson combination teaches the use of keywords for filter emails; however the Kirsch-Aronson combination does not explicitly teach the weighting of keywords.

Goldberg teaches different weights may be assigned to different keywords, wherein certain keywords have higher weights than other keywords (col. 6, lines 17-50).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of the Kirsch-Aronson combination regarding filtering emails using keywords with the teachings of Goldberg regarding weighting of keywords because weighting makes for better filters (Goldberg, col. 6, lines 17-50).

24. As to claims 25 and 27, they are rejected for the same reasons as claim 23.

### ***Response to Arguments***

25. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Art Unit: 2142

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

27. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B Blair whose telephone number is 571-272-3893. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

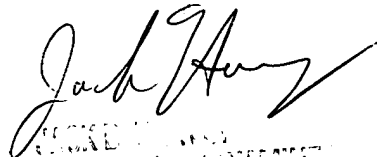
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on 571-272-3896. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2142

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Douglas Blair

DBB

  
JACK H. HAYS  
SUPERVISOR, PATENT EXAMINER